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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,300	07/31/2001	Gordon E. King	210121.547	3873

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EXAMINER

LY, CHEYNE D

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,300

Applicant(s)

KING ET AL.

Examiner

Cheyne D Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/05/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6, 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's election of Group VIII, claims 12 and 13, polypeptide SEQ ID NO:1789 encoded by SEQ ID NO:1788, in Paper No. 10, filed December 05, 2002, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. It is acknowledged that claims 1-11 and 14-17 have been cancelled.
3. Claims 12 and 13 are examined on the merits.

### IDS

4. Documents AD and AH listed in Paper No. 11, filed December 06, 2002, have not been considered because the instant application does not contain English-language translations to the foreign documents as is required for consideration for a reference. For a document published in a non-English-language, a copy of the translation of the document to the English-language is required. (See MPEP § 609)

### LACK OF UTILITY UNDER 35 U.S.C. § 101:

5. The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.
6. The examiner is using the following definitions in evaluating the claims for utility.

"Specific" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

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"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

7. Claims 12 and 13 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility.

8. The critical limitation of claims 12 and 13 is the method for stimulating an immune response and treatment of a cancer patient using the claimed polypeptide SEQ ID NO: 1789 which is encoded by SEQ ID NO:1788. It is acknowledged that some data are supplied for several sequences, such as expression data for clone I.D. 72239 and 72237 on page 138. However, no specific data therein indicate the specific identity and the corresponding function of the critical limitation, SEQ ID NO:1789. It is peculiar that the specification does not provide specific disclosure to the identity of SEQ ID NO:1789, when the claimed invention is directed to a method that relies on the specificity of the said polypeptide for stimulating a specific immune response and treatment of a cancer patient. It is acknowledged that it is well known in the art that

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any antigen could be used to stimulate an immune response (Janeway et al. 2001, Pages 1 and 2). However, the lack of specific identity of the immunogen used such as SEQ ID NO: 1789 causes the method of generating such a response to be nonspecific. The lack of disclosure of the identity and function of SEQ ID NO:1789 causes the method that uses the polypeptide of SEQ ID NO:1789 for the treatment of a cancer in a patient to be nonspecific. Further, a method lacks substantial utility when the starting material of the said method itself has no specific utility. Therefore, the lack of specific and substantial disclosure of the identity and the corresponding function of SEQ ID NO: 1789 and its corresponding nucleotide SEQ ID NO:1788 causes claims 12 and 13 to lack utility under U.S.C. §101.

9. Further, the claimed polynucleotide is not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, a nucleic acid may be utilized to obtain a protein. The protein could then be used in conducting research to functionally characterize the protein. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case, the protein produced as a final product resulting from processes involving the nucleic acid does not have asserted or identified specific and substantial utilities. Identifying and studying the properties of a protein itself or the mechanisms in which the protein is involved, such as the polypeptide SEQ ID NO: 1789 which has been determined to be similar to the EIA enhancer binding protein at the nucleotide level, does not define a “real world” context for use. Similarly, the other listed utilities and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to many such compounds.

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1. It is acknowledged that Applicants disclose in Example 3 (Page 140) that SEQ ID NO: 1788 was derived from a sequence search against the GenBank database. The result of the GenBank database search is an EIA enhancer binding protein. SEQ ID NO:1788 (C1491P) was found to have some similarity to an EIA enhancer binding protein (Page 140, lines 11-13). However, the disclosure of the similarity of a particular sequence to another by sequence comparison without specific and substantial disclosure as to the specific identity and function of a nucleotide composition as defined by specific and substantial biological activity does not support the claimed asserted utility of the said composition. It is noted that applicant has identified a sequence which is known in the prior art and which has a stated sequence similarity to the claimed sequence. Absent factual biological activity data, one skilled in the art would have reason to doubt that sequence similarity alone would reasonably support the assertion that the biological activity of the claimed subject matter would be the same as that of the similar sequence. Furthermore, it is unclear whether the similar sequence identified in the prior art has actually been tested for the biological activity or whether this also is an asserted biological activity based upon sequence similarity to yet a different sequence.

10. Note that it would have been well known in the art that sequence similarity does not reliably correlate to structural similarity and that structural similarity does not reliably result in similar or identical biological activities. For example, it would have been well known that even a single nucleotide or amino acid change or mutation can destroy the function of the biomolecule in many instances, albeit not in all cases. In the absence of factual biological activity data characterizing the structural and functional components of the biomolecule, the effects of these changes are largely unpredictable as to which ones will have a significant effect and which ones

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will be silent mutations having no effect. Several publications document the unpredictability of the relationship between sequence, structure, and function, although it is acknowledged that certain specific sequences have been found to be conserved in biomolecules having related function following a significant amount of further research. See Lopez et al. (Molecular Biology, 32:881-891, 1999); Attwood (Science, 290:471-473, 2000); Gerhold et al. (BioEssays, 18(12):973-981, 1996); Wells et al. (Journal of Leukocyte Biology, 61(5):545-550, 1997); and Russell et al. (Journal of Molecular Biology, 244:332-350, 1994). However, this level of factual biological activity data is absent here.

#### **Claims Rejected Under U.S.C. § 112, First Paragraph**

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

#### **LACK OF ENABLEMENT**

12. Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

13. Since the claimed invention is not supported by a specific, substantial, and credible utility or a well-established utility for the reasons set forth above (refer to 35 U.S.C. § 101 rejection), one skilled in the art would not know how to use the claimed invention.

### **LACK OF WRITTEN DESCRIPTION**

2. Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

14. The specification discloses polypeptide SEQ ID NO: 1789, which is encoded by SEQ ID NO:1788. Claims 12 and 13 are directed to polypeptides comprising an amino acid sequence having at least 90% identity to the sequence set forth in SEQ ID NO:1789, which encompasses sequences of the sequence length of SEQ ID NO:1789 that have at least 90% identity to SEQ ID NO:1789 and sequences greater than the length of SEQ ID NO:1789 that have at least 90% identity to the SEQ ID NO:1789. For example, the variation in sequence identity between SEQ ID NO:1789 and a larger sequence could be due to the difference in nucleotide sequences that are beyond the sequence length of SEQ ID NO:1789. The sequence variability in this area could result in the larger sequence having at least 90% identity to SEQ ID NO:1789. None of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)



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15. With the exception of SEQ ID NO:1789, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that: ...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.* , 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli* , 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood* , 107 F.3d at 1572, 41 USPQ2d at 1966.

16. Therefore, only SEQ ID NO: 1789 but not the full breadth of the claims 12 and 13 meet the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115)

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### CONCLUSION

17. NO CLAIM IS ALLOWED.

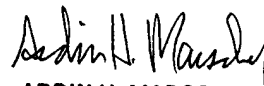
18. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

21. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly  
2/5/03

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER